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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,526	07/27/2000	Evan D.H. Green	NFC1P004X1	1198

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03/13/2003

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EXAMINER

JACKSON, CORNELIUS H

ART UNIT

PAPER NUMBER

2828

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/626,526		GREEN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Cornelius H. Jackson		2828	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.


- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 88-92, 97-99 and 101-128 is/are pending in the application.
- 4a) Of the above claim(s) 126-128 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 88-92, 97-99 and 101-125 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

  
**PAUL IP**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2800**

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Acknowledgement***

1. Acknowledgement is made that applicant's Amendment, filed on 13 May 2002, has been entered. Upon entrance of amendment, claims 93-96 and 100 were cancelled, claims 88-90, 97-99 and 101 were amended and new claims 102-128 were added. Claims 88-92, 97-99 and 101-128 are pending in this application, with claims 126-128 being withdrawn from consideration.

### ***Election/Restrictions***

2. Newly submitted claims 125-128 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Distinctness is proven for claims in this relationship if the intermediate product (a tunable filter) is useful to make other than the final product (a communication apparatus) (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful in a laser printer/copier and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the

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inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 125-128 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Specification***

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Objections***

4. Claims 90-92 are objected to because of the following informalities: Claim 90 depends on claim 90. Also, the word "selector]" in line 3 of claim 90 should be changed to "selector". Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 88-92, 97-99 and 101-125 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sesko et al. (6205159) in view of Deacon (6243517). Sesko et al. teach a tunable filter apparatus **Fig. 2A**, comprising a grid generator **4** positioned in an optical path and configured to generate a first transmission peaks corresponding to channels of a selected wavelength grid, **see col. 11, lines 46-49**; and a channel selector **5** positioned in the optical path and configured to generate a second plurality of transmission peaks, **see col. 11, lines 52-56 and col. 12, lines 46-48**. Sesko et al. fails to teach the grid generator is configured to generate a plurality of transmission peaks. Deacon teaches that use of a single or plurality of transmission peaks for vernier tuning is well known in the art **see col. 13, lines 8-37 and col. 31, line 23-col. 32, line 24** and within the general skill of a worker in the art to select a known method on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 89, Sesko et al. teach the stated limitation, **see col. 12, lines 46-53**.

Regarding claims 90-92 and 101, Sesko et al. teach the stated limitation including a gain medium 1, **see col. 11, lines 35-56 and col. 13, lines 23-38.**

Regarding claims 102-105, Deacon teach all the stated limitations, **see col. 31, line 23-col. 32, line 24.**

Regarding claims 106, Sesko et al. teach the grid generator and the channel selector comprise a Fabry-Perot filter/an interference element, **see abstract, col. 9, lines 3-14.**

Regarding claim 108, 109 and 111, Sesko et al. teach all the stated limitations, **see Figs. 2A-F and col. 11, line 35-col. 12, line 60.**

Regarding claims 107, 110, 112-115, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 97-99 and 116-125, the method of a device is not germane to the issue of patentability of the device itself, since the device itself obviously uses the method. Therefore the rejection used on the device applies also to the method of the device.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 88-92, 97-99 and 101 have been considered but are moot in view of the new ground(s) of rejection.

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cornelius H. Jackson whose telephone number is (703) 306-5981. The examiner can normally be reached on 8:00 - 5:00, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Ip can be reached on (703)308-3098. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7721 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.



chj  
March 7, 2003



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